

REMARKS

Applicant thanks the Examiner for her careful consideration of this case.

Claims 8-22 and 24-37 are currently pending in the application.

Claims 35-37 stand rejected under 35 U.S.C. § 112 first paragraph. In addition, the claims are provisionally rejected under the judicially created doctrine of obviousness-type double patenting over co-pending application No.: 10/462,127.

Amendments to the Claims

Claim 8 has been amended, Claims 32-37 have been canceled and new claims 38-44 have been added. Claims 9-22 and 24-31 remain unchanged. Claims 1-7 and 23 were canceled in a previous Amendment. Applicant respectfully submits that no new matter is added through the proposed amendment to the claims. Specifically, claim 8 has been amended to be consistent with the elected group (*i.e.*, at least one of variables R^1 , R^2 , R^{X2A} and R^4 comprises a cycloheteroaliphatic or heteroaromatic moiety). New claim 38 finds support *inter alia* in claims 9, 14, 17 and 25. In addition, canceled claims 32-37 have been re-written as new claims 39-44 to present the claims in logical order (in view of the addition of new compound claim 38). Claim 42 finds support in (now canceled) claim 35, and is directed to a method for inhibiting β -secretase activity in a biological sample. Claim 43 finds support in (now canceled) claim 36, and has been re-written to adopt the Examiner's suggestion (*i.e.*, remove "preventing" from the claim language).

No new matter is being introduced by these amendments. Applicant is submitting the present amendments without prejudice to the subsequent prosecution of claims to some or all of the subject matter which might be lost by virtue of this paper, and explicitly reserves the right to pursue the subject matter of any of the canceled claims, or some or all of the subject matter which might be lost by virtue of this paper, in Divisional or Continuation Applications.

Below we address each of the rejections stated in the Office Action as if it were applied to the newly amended claims.

1. Rejection under 35 U.S.C. § 112, first paragraph

The Examiner has rejected claims 35-37 under 35 U.S.C. § 112, first paragraph. Specifically, the Examiner states that, while the specification is enabling for inhibiting the enzyme activity (*i.e.*, β -secretase), it does not reasonably provide enablement for preventing any and all disorders related to the enzyme activity.

As discussed above, claims 35-37 have been canceled, and the corresponding subject matter has been re-introduced in new claims 42-44. Claim 42 recites a method for inhibiting β -secretase activity in a biological sample. Applicant respectfully submits that such language is fully supported and enabled by the specification as originally filed.

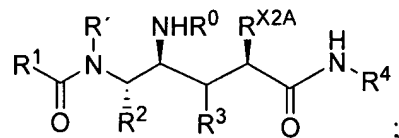
With respect to claim 43, Applicant has adopted the Examiner's suggestion to remove the term "preventing."

Applicant respectfully submits that the § 112 rejection of record is moot in view of the claim amendments, and requests that the stated rejection be withdrawn.

2. Provisional Obviousness-type Double Patenting Rejection

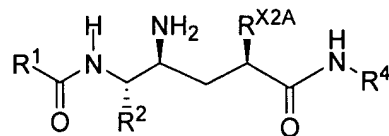
The Examiner has provisionally rejected claims 8-22 and 24-37 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of co-pending application No.: 10/462,127.

Applicant respectfully submits that claim 1 in the cited co-pending application has been canceled, thereby rendering moot the provisional obviousness-type double patenting rejection of record. In addition, Applicant submits that the claims currently pending in co-pending application No.: 10/462,127 are directed to compounds of the structure:



wherein none of the recited variables comprise a heterocyclic or heteroaromatic moiety.

The instant claims are directed to compounds of formula:



wherein at least one of R¹, R², R^{X2A} and R⁴ comprises a cycloheteroaliphatic or heteroaromatic moiety.

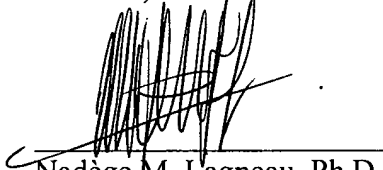
Accordingly, there is no overlapping subject matter between the presently claimed invention and co-pending application No.: 10/462,127. Applicant respectfully requests that the stated rejection be withdrawn.

CONCLUSION

Applicant thanks Examiner Lambkin for her time and consideration. If a telephone conversation would help clarify any issues, or help expedite prosecution of this case, Applicant invites the Examiner to contact the undersigned at (617) 248-5150.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that any additional fees are required for consideration of this paper (including fees for net addition of claims), these fees are authorized to be charged to our Deposit Account No. 03-1721.

Respectfully submitted,
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